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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,852	07/31/2003	Jonnie R. Williams	004859.00044	1976

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BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER	
MAYES, DIONNE WALLS	
ART UNIT	**PAPER NUMBER**
1731	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/630,852	WILLIAMS, JONNIE R.	
	Examiner	Art Unit	
	Dionne Walls Mayes	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-10,12-14 and 17-21* is/are rejected.

7)☒ Claim(s) *4,5,11,15,16 and 22* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 12- 14, 17-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,834,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claim 16, fully encompasses nearly all of the cited claims, with the exception of claims 20-22. Regarding these claims, it follows that one having ordinary skill in the art would have fabricated the powdered smokeless tobacco product of Virginia flue-cured tobacco, or an extract of tobacco, since such types of tobacco are used in other claimed embodiments of US. Pat. No. 6,834,654.

3. Claims 1-3, and 6-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,834,654 in view of Sensabaugh, Jr. et al.

Claim 16 nearly encompasses all of the cited claims, but it may not claim that wintergreen is added to the smokeless tobacco product; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to have added such product to the claimed tobacco composition because, as stated in Sensabaugh, Jr. et al, snuff (which is powdered tobacco) typically includes a strong flavoring ingredient, such as wintergreen, to give the product a distinctive flavor in addition to the "snuff" taste (See col. 2, lines 34-37).

4. Regarding claims 9-11, Regarding these claims, it follows that one having ordinary skill in the art would have fabricated the powdered smokeless tobacco product of Virginia flue-cured tobacco, or an extract of tobacco, since such types of tobacco are used in other claimed embodiments of US. Pat. No. 6,834,654.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-3, 9-10, 12-14, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atchley et al (US. Pat. App. Pub 2003/0094182) in view of Sensabaugh, Jr. et al (US. Pat. No. 4,528,993).

Atchley et al discloses, in its "Background" section, that snuff is a finely ground powdery tobacco product that is often treated with a variety of flavors to

help diminish some of the less desirable taste characteristics associated with the tobacco base (See para. 005). While Atchley's "Background" may not state that wintergreen, peppermint, and menthol flavors are added to the snuff, it is very well-known that mint and menthol are common flavorants used in the tobacco art. Further, Sensabaugh, Jr. et al states that snuff (which is powdered tobacco) typically includes a strong flavoring ingredient, such as wintergreen, to give the product a distinctive flavor in addition to the "snuff" taste. (see col. 2, lines 34-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have included the claimed amounts of mint, including peppermint and spearmint, menthol and wintergreen flavors to the smokeless tobacco product disclosed in the "Background" of Atchley et al in order to provide the user with a pleasant organoleptic experience while using the tobacco product.

Regarding claims 9 and 20, while the combined references may not specifically state that the snuff product consists essentially of Virginia flue-cured tobacco, it would have been obvious to one having ordinary skill in the art at the time of the invention to have chosen this type of tobacco because such tobacco is commonly used in the tobacco art.

7. Claims 6-8 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atchley et al (US. Pat. App. Pub 2003/0094182) in view of Sensabaugh, Jr. et al (US. Pat. No. 4,528,993), as applied to claim 1, above, and further in view of WO 00/15056.

While the combined references of Atchley et al and Sensabaugh, Jr. et al may not specifically disclose that the tobacco comprising its snuff product has the claimed nitrosamine content, WO 00/15056 discloses a tobacco product, comprised from Virginia flue-cured tobacco leaves, which can be converted to snuff tobacco (corresponding to the claimed "smokeless tobacco product') which has a combined TSNA (corresponding to the claimed "collective content of NNN, NNK, NAT, NAB') as low as less than about .009 micro g/g (corresponding to the claimed "0.3/0.2/0.1 micro g/g or less") (see pages 28 and 29). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the tobacco snuff product of Atchley modified by Sensabaugh, Jr. with the nitrosamine content disclosed in WO 00/15056, in order to provide a less-carcinogenic tobacco product as taught in WO 00/15056.

Allowable Subject Matter

8. Claims 4-5, 11, 15-16 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dionne Walls Mayes
Primary Examiner
Art Unit 1731

September 29, 2005